

**Remarks**

Claims 12 and 20-25 are currently pending and under examination. Claim 12 has been amended. A supplemental Sequence ID Listing accompanies this response. The following rejections are at issue and are set forth by number in the order in which they are addressed:

1. Claims 12 and 20-25 are rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking an adequate written description;
2. Claims 12 and 20-25 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Harper et al., U.S. Pat. Pub. 2002/0160378.

Unless otherwise noted, the claims have been cancelled or amended to further Applicant's business interests and the prosecution of the present application in a manner consistent with the PTO's Patent Business Goals (PBG; 65 Fed. Reg. 54603 (September 8, 2000)), and not in acquiescence to the Examiner's arguments and while reserving the right to prosecute the original (or similar) claims in the future. None of the claim amendments made herein are intended to narrow the scope of any of the amended claims within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) or related cases.

**1. The Claims Have An Adequate Written Description**

Claims 12 and 20-25 are rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking an adequate written description. This rejection is a new matter rejection. Claim 15 of the originally filed specification specifies a sequence that is "at least 85% homologous to SEQ. ID No. 1." Thus, the claims as originally filed clearly establish that the Applicants contemplated any amount of homology greater than 85%. As 95% is greater than 85% (i.e. 95% is at least 85%) that range is clearly within the teaching of the specification. The subject matter of claim need not be described literally or "in *ipsis verbis*" in order for the specification to satisfy the written description requirement. See, e.g., *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (C.C.P.A. 1971). It is clear that the claimed limit of 95% homology is within the ranges taught in the specification. Thus, support for the claim limitations exists and the claim limitations are new matter. In this regard, the limitations are similar to those addressed by the CCPA in *In re*

Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). There, the specification described a step of a process as achieving a solids concentration of a coffee extract of 25-60% and gave specific examples of 36% and 50%. The claims at issue specified a solids concentration of between 35% and 60%. The CCPA overturned the rejection of this claim, finding that the narrowed range was within the range taught in the patent specification. *Id.* at 264, 191 USPQ at 98. In the instant case, the limit of 95% homology is clearly within the limits taught in the specification. There is no new matter. Applicants respectfully request that this ground of rejection be withdrawn.

## **2. The Claims Are Not Anticipated**

The Examiner has rejected Claims 12 and 20-25 under 35 U.S.C. §102(e) as allegedly being anticipated by Harper et al., U.S. Pat. Pub. 2002/0160378. The claims have been amended to specify that the transformed plant is exposed to cold or drought stress. Support for this amendment is found at paragraphs 37, 38 and 167. Harper et al. does not teach the specific step of exposing plants transformed with SEQ ID NO:1 to cold or drought stress. Thus, the claims are not inherently or explicitly anticipated by Harper et al.

The Examiner's attention is respectfully directed to Column 80, table 7 of Harper et al. SEQ ID NO:2316 is identified in Table 7 as being a saline stress responsive sequence. SEQ ID NO:2316 is not identified as a cold responsive sequence in Table 3 (columns 72-75) or as an osmotic stress related sequence in Table 11 (column 82), or as cold and saline responsive sequence in Table 18 (column 86). Thus, Harper et al. does not teach exposing plants transformed with SEQ ID NO:2316 to cold or drought stress.

Again, paragraph 0031 of Harper et al. does not teach that all of the more than 4000 sequences disclosed in Harper et al. all confer multiple types of stress tolerance. The specific stress that a particular sequence modulates are not identified in paragraph 0031. Thus, this paragraph is not relevant to the actual function of SEQ ID NO:1 and is not relevant to anticipation of the instant claims.

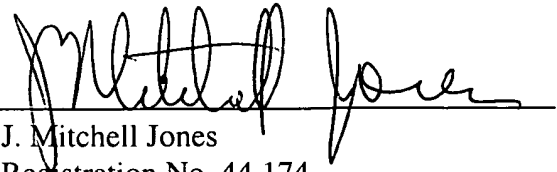
As such, the anticipation rejection should be withdrawn.

## **Conclusion**

All grounds of rejection and objection of the Office Action of October 17, 2006 having

been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements for patentability and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

Dated: February 20, 2007

A handwritten signature in black ink, appearing to read "J. Mitchell Jones", is written over a horizontal line.

J. Mitchell Jones  
Registration No. 44,174

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
608/218-6900